

Application No.: 09/677,831
Preliminary Amendment dated: June 28, 2005
Reply to Office Action of: March 18, 2005

REMARKS

In view of the final office action, Applicants are submitting a Request for Continued Examination (RCE) with this preliminary amendment. By this preliminary amendment, claims 34 and 35 have been canceled without prejudice or disclaimer, claim 29 has been amended, and new claims 36-38 have been added. In view of the foregoing amendments and following arguments and remarks urged here, Applicants respectfully request that the Examiner reconsider all outstanding rejections, and that they be withdrawn.

Rejection Under 35 U.S.C. §103

At paragraph 7 of the Final Office Action¹, the Examiner rejected claims 1-4, 6-9 and 29 as being unpatentable over U.S. Patent No. 5,825,353 to Will (“Will”) in view of U.S. Patent No. 5,734,706 to Windsor et al. (“Windsor”). The Examiner also took Official Notice that “the list record being a call list record, including the claimed call details is well known in the art and not invented by the applicants.”

Will is generally directed to the control of a handheld miniature personal digital assistant (PDA). Will teaches using complex menus that display items for use by sophisticated applications, including those that require the entry of alphanumeric data, such as a telephone and address directory and date book. The Examiner referred to FIG. 8a of Will as showing the retrieval of an address record from an address directory, and referred to FIGS. 8b and 8d for the display of the details of an identified address record.

The Examiner then admitted that Will did not show “the list record being a call list record, including the claimed call details.” It is at this point that the Examiner took Official Notice that “the list record being a call list record, including the claimed call details is well known in the art and not invented by the applicants.”

Applicants traverse this “well known” statement because the technical line of reasoning underlying the Examiner’s decision to take such notice is unclear. In particular,

¹ At paragraph 7, the Examiner referred to the rejection outlined in paragraph 9 of the Office Action dated January 16, 2004.

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Applicants note that Windsor at FIG. 7C discloses a phone log in a non-PDA context. If the Examiner is taking official notice merely of the existence of a phone log, then citing Windsor would appear to be sufficient. By not relying or even mentioning FIG. 7C of Windsor, however, the Examiner appears to be taking notice of a particular fact beyond a phone log. For example, is the Examiner taking notice of phone log in a PDA context? Such would be required in justifying a modification of the teachings of Will. If the Examiner is making such a contention, then Applicants submit that the Examiner is taking Official Notice of a significant measure of the Applicants' invention, which relates to the integration of a call list into a telephone application in a PDA device. In that regard, Applicants submit that more specific factual findings and concrete evidence are required by the Examiner to justify such a position.

An analysis of the disclosure of Windsor further points to the need for additional justifications for such a position by the Examiner.

Windsor is generally directed to the use of a conversion device for retrieving call detail information from incoming and outgoing calls. The retrieved call detail information can then be written to a database and displayed on a display unit. In the Office Action, the Examiner noted that Will did "not disclose a tap recognizer and wherein the display device is configured to select a tapped list record and to initiate a call, in a method of managing a phone device, for the purpose of providing identification of both incoming and outgoing calls."

The tap recognizer element of Applicants' claim 1 is supposedly met by the conversion device 22 of Windsor. As illustrated in FIG. 1 of Windsor, the conversion device 22 is coupled to both a telephone station 26 and a computer system 34 by means of data connections. The conversion device may either be a stand alone device or in a computer interface board format for direct installation into a well known computing device. *See*, col. 4, line 45 to col. 5, line 13 of Windsor. In operation, the conversion device can retrieve information (e.g., calling party's name, calling party's phone number information, time and date of the call, type of call, telephone line call was placed on, etc.)

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from a call and make it available to the computing device for storage and display. As noted above, an example of a phone log is illustrated in FIG. 7C of Windsor.

In applying Windsor to Applicants' claim 1, the Examiner asserted that the conversion device was analogous to Applicants' tap recognizer. At page 16, lines 9-11, Applicants describe a tap recognizer as an element that enables recognition of tapping on the screen. Even with the Examiner's broad interpretation of a tap recognizer that apparently refers to a conversion device that taps into a telephone call, Windsor still cannot be applied to Applicants' claim 1. As claim 1 recites, the "phone device includes a tap recognizer." Windsor's conversion device, on the other hand, is defined to be distinct from a telephone station. The only integration of the conversion device with another component in Windsor is with the computer system. Therefore, Windsor's conversion device cannot be applied to Applicants' tap recognizer.

In summary, Applicants submit that the Examiner's rejection is deficient for at least the following reasons: (1) the Examiner's appears to be taking Official Notice of a fact beyond a phone log, which fact is not specified nor supported by factual findings and concrete evidence; (2) Windsor does not appear to show a phone device including a tap recognizer; and (3) no basis for modifying the teachings of Will with a call list record has been provided. For at least these reasons, Applicants submit that the Examiner has not presented a *prima facie* case of obviousness with respect to claim 1. The rejection of claim 1 is therefore traversed.

Since claims 2-4 and 6-9 are dependent either directly or indirectly from independent claim 1, the rejection of claims 2-4 and 6-9 is also traversed for at least the reasons noted above.

Applicants further note that claim 29 has been amended to be dependent on previously allowed independent claim 24. The rejection of claim 29 is therefore rendered moot.

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Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. The Examiner is invited to telephone the undersigned representative if an interview might be useful for any reason.

Respectfully submitted,
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